

media transfer determining whether to transfer image data between physical media, the media transfer determining comprising transferring the image data from external media to internal media through a memory; upload transfer determining whether to upload the image data to a network, the upload transfer determining comprising determining a remote target and uploading the image data from external media to the network; transferring a computer image file from a network storage; dispensing the portable digital storage media; and selecting a remote target and transferring the computer image file from the network storage to the portable digital storage media before the step of dispensing the portable digital storage media at the remote target. Claims 8 and 12 recite similar features.

The Office Action alleges that Wasilewski can reasonably be considered to teach many of the features positively recited in the pending claims, except for where the purchase includes the purchase of a blank portable digital storage media at the kiosk which the Office Action relies upon Roe as teaching. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to combine Wasilewski with Roe because Roe discloses a kiosk where digital storage media may be purchased. The analysis of the Office Action fails for at least the following reasons.

Wasilewski is directed to a method of integrating photographic imaging products and services functionality with non-imaging functionality using automatic teller machine functions for providing financial transactions (Abstract). Wasilewski, as the Office Action concedes, does not disclose expressly wherein the purchase determining whether to purchase blank media.

Roe, as noted above, is relied upon as disclosing the purchase of blank portable digital storage media at the kiosk. Roe teaches a vending machine system for vending computer storage media (Abstract).

The Office Action summarily concludes that it would have been obvious to combine Wasilewski with Roe to purchase the blank media storage device at the kiosk. To the extent that this is an objective of the Wasilewski device, the analysis of the Office Action regarding the combination of Roe with Wasilewski fails for at least the following reasons.

First, MPEP §2142 instructs that the proper standard by which to determine obviousness requires (1) that the Examiner step backward in time into the shoes of the hypothetical "person of ordinary skill in the art," (2) that "[i]n view of the factual information, the Examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at the time to that person," and (3) that any knowledge gained from Applicants' disclosure must be put aside in reaching this determination in order to avoid the tendency to resort to impermissible application of hindsight reasoning based on the roadmap provided by the Applicants' disclosure. Clearly, there is nothing in Wasilewski and/or Roe to suggest that one of ordinary skill in the art at the time of the Applicants' invention may have, in any way, predictably combined Wasilewski with Roe in the manner suggested by the Office Action, as such has not been adequately shown.

Second, to any extent that Roe teaches the purchase includes the purchase of a blank portable digital storage media at the kiosk, this is not a reasonable conclusion upon which to base the assertion that one of ordinary skill in the art would have predictably combined any of the teachings of the references as is suggested by the Office Action with any reasonable expectation of success in achieving the objectives which are intended to be achieved by, and in the manner of, the subject matter of the pending claims.

Third, even post *KSR*, the analysis supporting an obviousness rejection must be explicit. The Supreme Court in *KSR* approved the conclusions set forth in the decision of the Federal Circuit in *In re Kahn* (citations omitted) that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness." The standard is also not met here with the mere conclusory statement that one of ordinary skill in the art may have combined the method of integrating photographic imaging products and services functionality using an automatic teller machine function to provide financial transactions system of Wasilewski with the system of Roe "to purchase blank media at the kiosk." In other words, there is no rational underpinnings to the articulated reasoning.

Fourth, MPEP §2143 is explicit in setting forth exemplary rationales to guide the obviousness analysis in supporting a rejection under 35 U.S.C. §103. The mandate of this MPEP section is that "[t]he key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious." Not only is this standard ignored, but there is not even an attempt by the Office Action to frame the asserted obviousness rejection over this combination of applied references under any exemplary rationale set forth in the Patent Office's guidance to its Examiners.

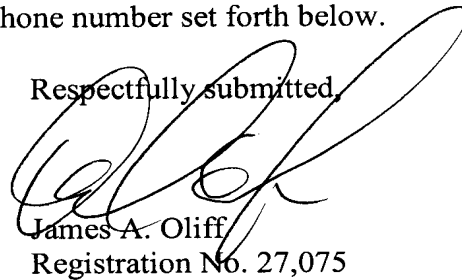
For at least the foregoing reasons, Wasilewski and Roe are not combinable in the manner suggested by the Office Action and the proper standard for showing such a combination has not been met. Further, any permissible combination of Wasilewski with Roe would not have suggested the specific combination of all the features positively recited in, for example, independent claims 1, 5 and 8. Finally, as claims 6, 9, 10 and 15 variously depend from claims 5, 8 and 12, they are allowable for their respective dependence directly or indirectly on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 5, 6, 8-10, 12 and 15 under 35 U.S.C. §103(a) as being unpatentable over the applied references are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 5, 6, 8-10, 12 and 15 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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